

REMARKS

In the Amendment, claim 1 has been amended to better recite the inventive concept of providing a control module at the TV set for controlling the scanning by a satellite receiver to locate satellite channels and covert them to UHF/VHF channels. The scan is initiated when the channel selector changes channels and the scan is stopped when video image signals are detected to determine that an appropriate satellite channel has been detected and converted to a UHF/VHF channel. This provides a closed control loop from the control module, through the satellite receiver, back to the TV set, and then back to the control module.

A second aspect of the invention is that this allows the use of a single control with only VHF/UHF channels and excluding satellite channels.

In the Office Action of Nov. 17, 2005, claims 1-6, 8-12, 15 and 16 were rejected over Dini, EP 0 288 928 in view of Ma et al., US Pat. No. 3,737,565.

The rationale in support of this rejection has been carefully reviewed. In particular, there are two incorrect conclusions stated in this rationale.

First, the Examiner states that Dini discloses that the user can select said VHF/UHF/Satellite channels with one remote control.

However, this conclusion is not responsive to the claim language which recited "on the TV home receiver, or through one remote control, which include only channels of the VHF/UHF range." This distinguishes from Dini because Dini uses channels in all three ranges so that a user can input satellite channel 101 or satellite channel 250. The control unit of the present invention does not allow input of satellite channels in this range; it uses only the VHF/UHF band.

Next, the Office Action states that it would be obvious to combine Dini's satellite channel receiving station with

Ma's tuning system to search for satellite channels in the manner of the present claimed invention.

This conclusion is incorrect for several reasons.

Dini's satellite receiver control unit 6 as shown in Fig. 1 has eight dedicated pairs of modulators and tuners for converting satellite channel signals to eight unused VHF channel signals. One modulator or tuner is needed for each channel. Dini says that the number of these modulators and tuners could be increased to seventeen, but they are all serving one customer.

The invention of claim 1 allows the use of one modulator to convert satellite channel signals for any of the satellite channels by scanning the satellite reception band under the control of the control module 16 connected to the TV set. This saves the use of seven modulator-tuner channels as used in Dini for one TV customer. Or, to put it another way, eight modulator-satellite receivers can be used to serve eight customers instead of one customer as taught by Dini.

But, the Examiner states that it would be obvious to change the arrangement in Dini by adding the tuner of Ma to each customer TV set to control each satellite receiver as taught by the present invention.

There are several reasons for not reaching this conclusion. Ma's teaching was available in 1973. Dini came along in 1988, but did not provide the scanning system suggested in the Office action despite the notorious and well known availability of Ma tuners on ordinary television sets. Chanteau is an example of the prior art in 1999 and it shows TV sets connected to receive signals from four receiver dishes 10-40 and modulators 11-41, but no scanning control of any of the modulators 11-41.

What the Examiner is lacking in the obviousness rejection is any motivation in 1999 to make the proposed modification to Dini as proposed in the Office action.

MPEP 2143.01 provides that: "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

MPEP 2143.01 further provides that "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)."

In the present invention, the change-over to a channel configured as a satellite channel is detected by the detector in the control module, as soon as a channel change/transmitter change is accomplished in the TV home receiver. The advantage arises from the fact that a user can select channels for both conventional VHF/UHF channels and satellite reception channels with one conventional VHF/UHF channel selection unit on the TV home receiver of a prior generation, or through one remote

control using channels in VHF/UHF range of channels. Thus, the invented process is automatic and is transparent to the user except for the addition of a "black box" in the form of the control module. In Dini, a specialized control 15 and a specialized controller 12 in the receiving station is used to address satellite channels, such as channels 101-250, and if such a channel is found, the image signals are then converted to one of the unused VHF channels. This is a different method using different apparatus than the present claimed invention.

Claims 5 and 6 have been canceled without prejudice.

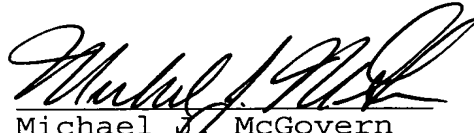
Claims 2-4 and 7-16 all depend directly or indirectly from claim 1, and are seen as allowable for at least the same reasons as claim 1.

CONCLUSION

After the Amendment and Remarks, claims 1-4 and 7-16 are still pending. Reconsideration of the application, and a Notice of Allowance for these claims is earnestly solicited.

Respectfully submitted,

By:


Michael J. McGovern
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202
(414) 277-5725
Attorney of Record